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Mary Ann Copas, Secretary

In the Application of: Liedtke, Björn
Ser.No.: 10/018,144
Filed: 14 December 2001
For: METHOD FOR PRODUCING A DATA CARRIER
Art Unit: 1734
Examiner: Purvis, Sue A.
Customer No.: 30996

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REPLY BRIEF TO EXAMINER'S ANSWER

The Applicant submits the following for its reply brief to the Examiner's Answer for the application on appeal and respectfully requests consideration of same. The Applicant respectfully requests withdrawal of the rejections made and that the Application be placed in line for Allowance.

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I. STATUS OF CLAIMS

Claims 32-40 and 42-62 remained pending prior to final rejection.

Claims 1-31 were originally filed. Claims 1-31 were cancelled by Preliminary Amendment and new Claims 32-62 were filed.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The statement of Claims in the Examiner's Answer is acknowledged as correct as follows:

1. Claims 51-55 and 61-62 stand rejected under 35 U.S.C. §102(a) as anticipated by Japanese Patent No. 11-126377.
2. Claims 32-35, 37-41, 43, 44, 46-50 stand rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent 6,200,402 to Amo in view of Japanese Patent No. 11-126377.
3. Claim 36 stands rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 6,200,402 to Amo in view of Japanese Patent No. 11-126377 and U.S. Patent No. 5,891,290 to Deurer et al.
4. Claim 45 stands rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 6,200,402 to Amo in view of Japanese Patent No. 11-126377 and U.S. Patent No. 6,004,420 to Nakamura et al.
5. Claims 56-69 stand rejected under 35 U.S.C. §103(a) as obvious over Japanese Patent No. 11-126377 in view of U.S. Patent No. 6,004,420 to Nakamura et al.
6. Claim 60 stands rejected under 35 U.S.C. §103(a) as obvious over Japanese Patent No. 11-126377 in view of U.S. Patent No. 6,200,402 to Amo and U.S.

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Patent No. 6,004,420 to Nakamura et al.

7. Claim 61 stands rejected under 35 U.S.C. §103(a) as obvious over Japanese Patent No. 11-126377.

VII. ARGUMENT

1. §102(a)-- Japanese Patent No. 11-126377

The Examiner has indicated in her Answer Brief that it is her opinion that the apparatus of independent Claim 51 is disclosed according to §102(a), stating specifically that Japanese Patent No. 11-126377 discloses:

an apparatus for bonding two substrates together including a lamination station for applying a first substrate (101) with a film (112). The station includes a pressure roller (51) with the substrate (101) being advanced linearly past the roller (51) during lamination.

Examiner's Answer, p. 4, paragraph 5.

The Applicant respectfully takes issue with the Examiner's characterization of the invention disclosed in Japanese Patent No. 11-126377. The only mention of "bonding two substrates" is found on page 21, paragraph 85 of the English translation of Japanese Patent No. 11-126377 (hereinafter, JP '377) provided with the Examiner's Answer. A reading of this paragraph shows that the invention in that reference is directed simply to having a double-sided disk with the light-transmitting film layer 112 disposed on the outsides of the resulting double sided disk. There is no adhesive film disclosed therein at all.

Claim 51, sets forth:

51. An apparatus for producing a data carrier having at least two substrates that are adhered to one another, comprising:
a laminating station for applying to a first substrate an adhesive film that is adhesive on two sides, wherein said laminating station comprises a rotatable pressure roller and a device for moving said first

substrate linearly past said pressure roller during lamination, wherein such movement extends parallel to a surface of said first substrate; and a substrate adhering station for aligning and joining said first substrate and a second substrate together.

Claim 51, as of last amendment, emphasis ours.

As can be seen, Claim 51 sets forth a laminating station "for applying to a first substrate an adhesive film that is adhesive on two sides"--the Examiner dismisses this element of the claim indicating that "the adhesive film set forth in the claim amounts to material worked upon and does not add any structural features to the claim since the apparatus of JP'377 would be capable of handling adhesive film that is adhesive on two sides." (Examiner's Answer, page 4, paragraph 4, last sentence.) However, the "adhesive film" is not the element set forth. The laminating station is the element. However, it is not just any laminating station, this is a laminating station that can apply double-sided adhesive film. This clearly limits the claim to that type of laminating station.

As a result of the limitation to a laminating station capable of applying a double-sided adhesive film, the JP'377 reference cannot anticipate the apparatus as disclosed in Claim 51 and its depend claims at issue, Claims 52-55 and 62. 35 U.S.C. §102(a) states:

A person shall be entitled to a patent unless . . . (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

35 U.S.C. §102(a).

JP '377 does not disclose nor even suggest a lamination station capable

of applying double-sided adhesive film to substrates, instead, it is directed toward an “information signal layer formed on a substrate . . . covered with adhesive agent, to uniform thickness. A cementing layer consisting of ultraviolet cured resin is than [sp] formed on the information signal layer. Then a transparent plastic film (112) at strain condition is laminated on the cementing layer.” (JP ‘377, Novelty Section, Derwent Abstract, p. 1, as Provided in First Office Action). The reference involves increasing capacity of an optical disc by using a thin transparent film of uniform thickness formed on the information signal layer. (JP ‘377, Advantage Section of Derwent Abstract, p. 2, as Provided in First Office Action). The reference describes in detail its application of the light transmission layer consisting of a transparent plastic on the substrate on which the information signal section was formed and the apparatus involved therein. (English translation p. 1, paragraph 0014 of Translation Provided in First Office Action) It is further described in the figures and text that the adhesives are spread as a liquid by “adhesive coaters”, and that these adhesives will “flow” when placed on the substrate. It is further disclosed the adhesives must have a viscosity sufficient to allow such flow to prevent the adhesive from falling from the substrate. (See paragraphs 0019, 0020, 0026, 0028, 0030, and 0034 of JP ‘377 English Translation Provided in First Office Action and Figures 1 and 6 showing adhesive coaters 11 and disposed adhesive.) Therefore, there is no disclosure of a lamination station capable of disposing a double-sided adhesive film on a substrate in JP ‘377. Instead, the reference teaches using liquid substance with a sufficient viscosity that “flows” onto the substrate as its adhesive. This adhesive is then used to adhere a thin film to the substrates

outside surface, even on the embodiment having two substrates adhered together as a double sided disk (Translation, p. 21, paragraph 0085, and Fig. 14.)

Clearly, the JP '377 reference actually teaches away from the present Application's laminating station for applying an adhesive film that is adhesive on two sides to a substrate. "Anticipation under 35 U.S.C. § 102 . . . requires the presence in a single prior art disclosure of each and every element of a claimed invention." Electro Med. Sys. S.A. v. Cooper Life Sciences, 34 F.3d 1048, 1052, 32 USPQ2d 1017, 1019 (Fed.Cir.1994). JP '377 does not teach each and every element since the lamination station disclosed therein is incapable of applying a double-sided adhesive film.¹ As a result, there can be no anticipation under §102(a) since each and every element is not disclosed within the cited JP '377 reference.

The indication that the cited reference, JP '377 "discloses all the apparatus limitations of the applicant's claim", is incorrect. (p. 8, numbered paragraph 13, Fifth Office Action). The Examiner has indicated that since the JP '377 reference discloses a lamination station for application of a transparent, non-adhesive film to the substrate, then the present application is anticipated since "Expressions relating the apparatus to contents thereof during an intended

¹ Please note that the Examiner, in her Answer, has boldly indicated that "the apparatus of JP'377 would be capable of handling adhesive film that is adhesive on two sides." (Examiner's Answer, page 4, paragraph 4, last sentence, see also, Examiner's Answer, page 10, last paragraph.) This bold statement is presented as fact without any support. Since the patent itself offers no teaching or suggestion of any adhesive film, much less double-sided, the Examiner's statement is inappropriate without a showing that the device in JP'377 is known to apply such adhesive film.

operation are of no significance in determining patentability of the apparatus claim. " *citing Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) (p. 8, numbered paragraph 13, Fourth Office Action). The Examiner, in her Answer has indicated that Applicant's reading of *Ex parte Thibault* is incorrect since "applicant has failed to notice that *Ex Parte Thibault* deals with both method and apparatus claims and was used by the examiner because it is contained as case law of interest in §2115 of the MPEP which states that 'material worked upon does not limit apparatus claims'." Applicant respectfully suggest that the Examiner is incorrect. A careful reading of the case in question shows that *Ex parte Thibault* is quite different from the application at issue. In that case, the applicant, in method claims, sought protection for a method to make a certain chemical, claiming a reservoir in that method claim. The cited reference, an apparatus protected by apparatus claims, disclosed a vaporizer, a heater, a cooler ("condenser"), and a cold trap, in sequence. The examiner there rejected the applicant's claim, finding that "a reservoir *** molten condition" read on either a heated or insulated tank, which heated tank was disclosed in the cited art. 164 U.S.P.Q. 666, 667 (1970). The existing patent had the generalized element into which the application's claimed reservoir could be found, and, as a result, the claim was not patentable. The materials handled in both instances were exactly the same. This differs from the instant case where the Examiner suggests that since JP'377 handles a film in a different manner than that in the present invention then it must anticipate the present invention. The materials worked upon are different in the instant case, distinguishing it. However, more important is that it is not that double-sided adhesive is claimed, but that a lamination

station is provided which can apply double-sided adhesive. The application is important and the elements of a lamination station which applies double-sided adhesive will differ from a lamination station that applies a simple, non-adhesive film, as is known in the art since either there will need to be an additional separation device for removing a protective film from at least one side of the double-sided adhesive film, or the intervening rollers will need to be of a non-stick surface, inherent in the disclosure that the film to be used is a double-sided adhesive. In the cited reference, the film is applied to an adhesive, so neither a separation device nor non-stick guide rollers would be disclosed, therefore making a "lamination station for applying a [double-sided adhesive film]" as found in Claim 51 and therefore all its dependent claims a much different device than a lamination disclosed in JP'377. The Applicant respectfully suggests that given such, and since "[a]nticipation under 35 U.S.C. § 102 . . . requires the presence in a single prior art disclosure of each and every element of a claimed invention", Electro Med. Sys. S.A. v. Cooper Life Sciences, 34 F.3d 1048, 1052, 32 USPQ2d 1017, 1019 (Fed.Cir.1994), then there can be no anticipation by JP '377. As a result, the Applicant respectfully request that the Examiner's rejections under §102(a) be withdrawn.

2. §103(a)--U.S. Patent 6,200,402 to Amo in view of JP'377

Claims 32-35, 37-41, 43-44, and 46-50 stand rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent 6,200,402 to Amo (hereinfter, "Amo", "Amo patent", or "Amo '402") in view of JP'377. 35 U.S.C. §103(a) sets forth that:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the

differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35 U.S.C. §103(a).

Independent Claim 32, from which all the remaining claims of the rejected set depend, is set forth as follows:

32. A method of producing a data carrier by adhering at least two substrates to one another, said method including the steps of:
providing a first substrate;
pressing an adhesive film, which is adhesive on two sides, against said first substrate via a rotating pressure roller by moving said first substrate linearly past said pressure roller, wherein such movement extends parallel to a surface of said first substrate;
aligning a second substrate relative to said first substrate; and
joining said first and second substrates together.

The subject matter of Claim 32 as a whole would not have been obvious to a person having ordinary skill in the art. A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. In re Dembiczak, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed.Cir.1999). However, a critical step in analyzing the patentability of claims pursuant to §103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-

accepted wisdom in the field. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id., quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed.Cir.1983)). Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir.1998). Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See Id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, **there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.** See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed.Cir.1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed.Cir.1984) (emphasis ours).

Claim 32 is not obvious over Amo in view of JP '377 since there is no suggestion or motivation to modify the teachings of either reference to make the specific combination that was made by the Applicant. The Examiner indicated that "Amo does not teach moving the substrate during lamination." (Second Office Action, p. 3, numbered section 4, paragraph 3.) The Examiner indicates in her rejection that "JP '377 discloses having the substrate move as a film is pressed thereon. [And], [i]t would have been obvious to one having ordinary skill in the art at the time the invention was made based on the teachings of JP '377 that an obvious alterative [sp] to having the

pressure roller move past the substrate is to have the substrate move past the pressure roller, because the two actions are functionally equivalent expedients." (Second Office Action, p. 3, paragraphs 5 and 6.) However, the teachings of the references, their relatedness to the field of the applicant's endeavor, and the knowledge of persons of ordinary skill in the field of the invention, are all relevant considerations. See In re Dance, 160 F.3d 1339, 1342 (C.A.Fed.,1998), *citing In re Oetiker*, 977 F.2d at 1447, 24 USPQ2d at 1445-46; In re Gorman, 933 F.2d at 986-87, 18 USPQ2d at 1888; In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed.Cir.1991). When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention. In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed.Cir.1988) (emphasis ours). Therefore, for combination of the references to be proper, the Examiner would have to determine whether selection of the specific teachings she has applied from each reference are identified by some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention. The Examiner has not referenced any such teaching or suggestion, but instead has said that the two actions are functionally equivalent expedients. The Applicant respectfully disagrees with the Examiner's conclusion and asserts that the proper showing of teaching or suggestion to combine the references and elements has not been made.

The Examiner's references may both be in the broad field of the manufacture of

optical discs, however, the areas of art she seeks to combine differ enough that combination would not be obvious. The Amo reference is in the same field as the Applicant's invention, as it discusses adhering two substrates to provide a data carrier. However, the JP '377 reference is in an unrelated field for the proposition asserted since JP'377 deals primarily with the optical properties of discs, and methods of improving such, not with disc manufacture *per se*. In JP '377, as is clearly shown in Fig. 5, the adhesive is applied in liquid form. The laminating station illustrated in Fig. 5 serves merely for laminating a protective layer onto the liquid adhesive layer which serves to adhere the protective layer to the substrate. Furthermore, it is not clear from JP '377 just how the laminating station does function, and whether during the laminating process the substrate is moved by a device past a pressure roller and is moved parallel to the surface of the substrate--as required by the elements of Applicant's independent Claim 32 (and therefore the dependent claims of the rejected set). JP '377 never discloses a laminating film, and there is no teaching or suggestion to use one. There is no teaching or suggestion in either reference to motivate the combination of the references or the particular elements of the references drawn out by the Examiner to "create" Applicant's claims. As a result, the combination can only be inappropriate hindsight. Therefore, the Applicant respectfully requests that the rejections be withdrawn.

3. **§103(a)--U.S. Patent 6,200,402 to Amo in view of JP'377 and U.S. Patent No. 5,891,290 to Deurer et al.**

Claim 36 stands rejected under 35 U.S.C. §103(a) as obvious over Amo '402 in view of JP'377 further in view of U.S. Patent No. 5,891,290 to Deurer et al. (hereinafter, "Deurer patent", "Deurer reference" Deurer '290). 35 U.S.C. §103(a) sets forth that:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negated by the manner in which the invention was made.

As discussed in Section 2. above, Independent Claim 32, from which Claim 36 depends, is not obvious over the Amo patent in view of JP '377. As a result, all claims depending from such must not be obvious over these references unless a new reference which teaches or suggests the combination of the elements provides the missing elements and motivation for combination. The Examiner's stated rejection of Claim 36 regards the new reference Deurer only as to the differing element of Claim 36.

The remaining intervening claim elements are still only referred to as "shown" by Amo and JP'377. As a result, the arguments previously made regarding the improper combination of Amo and JP'377 (See Section 2.) are reasserted here. With regard to the applicability of the Deurer reference, Applicant respectfully asserts that the application is inappropriate here. Deurer in no way suggests *any relation* to the field of optical disc manufacture. There is no teaching or suggestion within Deurer or the Amo or JP '377 references to combine any of the them to achieve the invention of Claim 36 of the present application. As a result, the combination can only be improper hindsight. Therefore, the Applicant respectfully requests that the rejections be withdrawn.

4. **§103(a)--U.S. Patent 6,200,402 to Amo in view of JP'377 and U.S.**

Patent No. 6,004,420 to Nakamura et al.

Claim 45 stands rejected under 35 U.S.C. §103(a) as obvious over Amo '402 in

view of JP'377 further in view of U.S. Patent No. 6,004,420 to Nakamura et al. (hereinafter, "Nakamura patent", "Nakamura reference", or "Nakamura '420"). 35 U.S.C. §103(a) sets forth that:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negated by the manner in which the invention was made.

As discussed in Section 2. above, Independent Claim 32, from which Claim 45 depends, is not obvious over the Amo patent in view of JP '377. As a result, all claims depending from such must not be obvious over these references unless a new reference which teaches or suggests the combination of the elements provides the missing elements and motivation for combination. The Examiner's stated rejection of Claim 45 regards the new reference Nakamura only as to the differing elements of Claim 45. The remaining intervening claim elements are still only referred to as "shown" by Amo and JP'377. As a result, the arguments previously made regarding the improper combination of Amo and JP'377 (See Section 2.) are reasserted here. With regard to the applicability of the Nakamura reference, Applicant respectfully asserts that the application is inappropriate here. There is no teaching or suggestion within Nakamura '420 or the Amo or JP '377 references to combine any of the them to achieve the invention of Claim 45 of the present application. As a result, the combination can only be improper hindsight.

5. §103(a)-- JP'377 in view of U.S. Patent No. 6,004,420 to Nakamura et

al.

Claims 56-59 stand rejected under 35 U.S.C. §103(a) as obvious over JP'377 in view of U.S. Patent No. 6,004,420 to Nakamura et al. (hereinafter, "Nakamura patent", "Nakamura reference", or "Nakamura '420"). 35 U.S.C. §103(a) sets forth that:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negated by the manner in which the invention was made.

Section 1 discussed the §102(b) rejection for this reference. The Examiner in her Fifth Office Action, referenced the rejection of Claims 56-59 as obvious over JP'377 as applied in the §102(b) rejection, in view of Nakamura et al. (See Fifth Office Action, p. 6, numbered paragraph 9.)

A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.. In re Dembiczak, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed.Cir.1999).

A critical step in analyzing the patentability of claims pursuant to §103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a

hindsight syndrome wherein that which only the invention taught is used against its teacher." Id., quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed.Cir.1983)). Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir.1998). Thus, every element of a claimed invention may often be found in the prior art.. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, **there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.** See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed.Cir.1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed.Cir.1984) (emphasis ours).

Claim 51 is not obvious over JP '377 in view of the Nakamura reference since there is no suggestion or motivation to modify the teachings of either reference to make the specific combination that was made by the applicant. The Examiner indicated that "JP '377 does not detail the manner in which the substrates are pressed together. However it would be obvious to one having ordinary skill in the art at the time the invention was made based on Figure 14 that the substrates are held apart and then pressed together in a centered manner. JP '377 does not disclose if the substrates are pressed together in a vacuum or not" (Fifth Office Action, p. 6, numbered section 9, paragraph 2.) The Examiner indicates in her rejection that "It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a vacuum in the bonding step in JP '377 because Nakamura shows that it is well known

in the art to bond substrates together in a vacuum." (Fifth Office Action, p. 7, paragraph 2.) However, the teachings of the references, their relatedness to the field of the applicant's endeavor, and the knowledge of persons of ordinary skill in the field of the invention, are all relevant considerations. See In re Dance, 160 F.3d 1339, 1342 (C.A.Fed.,1998), citing In re Oetiker, 977 F.2d at 1447, 24 USPQ2d at 1445-46; In re Gorman, 933 F.2d at 986-87, 18 USPQ2d at 1888; In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed.Cir.1991). When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention. In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed.Cir.1988). Therefore, for combination of the references to be proper, the Examiner would have to determine whether selection of the specific teachings she has applied from each reference are identified by some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention. The Examiner has not referenced any such teaching or suggestion, but instead has said that the two actions are functionally equivalent expedients. The Applicant respectfully disagrees with the Examiner's conclusions and asserts that the proper show of teaching or suggestion to combine the references and the elements therein has not been made.

The Examiner's references may both be in the broad field of the manufacture of optical discs, however, the areas of art she seeks to combine differ enough that combination would not be obvious. The JP '377 reference is in an unrelated field for

the proposition asserted. In JP '377, as is clearly shown in Fig. 5, the adhesive is applied in liquid form. The laminating station illustrated in Fig. 5 serves merely for laminating a protective layer onto the liquid adhesive layer which serves to adhere the protective layer to the substrate. Furthermore, it is not clear from JP '377 just how the laminating station does function, and whether during the laminating process the substrate is moved by a device past a pressure roller and is moved parallel to the surface of the substrate--as required by the elements of Applicant's independent Claim 51 (and therefore the dependent claims of the rejected set). JP '377 never discloses a laminating film, and there is no teaching or suggestion to use one. There is no teaching or suggestion in either reference to motivate the combination of the references or the particular elements of the references drawn out by the Examiner to "create" Applicant's claims. As a result, the combination can only be inappropriate hindsight. Therefore, the Applicant respectfully requests that the rejections be withdrawn.

6. **§103(a)--U.S. Patent 6,200,402 to Amo in view of JP'377 and U.S.**

Patent No. 6,004,420 to Nakamura et al or JP'377 in view of Amo '402 and Nakamura '420.

Claim 60 stands rejected under 35 U.S.C. §103(a) as obvious over JP '377 in view of Amo '402 in view of U.S. Patent No. 6,004,420 to Nakamura et al. (hereinafter, "Nakamura patent", "Nakamura reference", or "Nakamura '420"). Claim 61 stands rejected under 35 Amo '402 in view of JP'377 further in view of Nakamura '420. 35 U.S.C. §103(a) sets forth that:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been

obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

As discussed in Section 5. above, Independent Claim 51, from which Claims 58, 60, and 61 depend, is not obvious over the Amo patent in view of JP '377. As a result, all claims depending from such must not be obvious over these references unless a new reference which teaches or suggests the combination of the elements provides the missing elements and motivation for combination. The Examiner's stated rejection of Claim 45 regards the new reference Nakamura only as to the differing elements of Claims 58, 60, and 61. The remaining intervening claim elements are still only referred to as "shown" by Amo and JP'377. As a result, the arguments previously made regarding the improper combination of Amo and JP'377 (See Section 2.) are reasserted here. With regard to the applicability of the Nakamura reference, Applicant respectfully asserts that the application is inappropriate here. There is no teaching or suggestion within Nakamura '420 or the Amo or JP '377 references to combine any of the them to achieve the invention of Claim 58, 60, and 61 of the present application. As a result, the combination can only be improper hindsight.

Therefore, it is respectfully requested that the rejections be withdrawn given the arguments outlined above and the prosecution history and that application be placed in line for allowance.

Respectfully Submitted,



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